

1 Remarks

2 Amendments to the claims

3 Claims 11 and 13 have been amended to put them into independent form by
4 incorporating therein the limitations of now-cancelled claim 9. No new matter has been
5 added.

6
7 Provisional Election of Single Invention

8 In the most recent Office action (dated November 12, 2003), the Examiner
9 indicated that claims 1-8 and 16-20 have been withdrawn "as being drawn to a non-
10 selected claimed invention, there being no allowable generic or linking claim." The
11 Examiner further stated that, "election was made **without** traverse in Paper filed on
12 10/14/2003." (Emphasis in original.)

13 The Applicants' contest this statement on two accounts.

14 In the first instance, the election made in the paper filed (i.e., received by the
15 USPTO) on October 14, 2003 was specifically made with traverse. (See page 7 line 20
16 of 10/14/03 paper.) The Applicants maintain their contention, raised in the 10/14/03
17 paper, that claims 1-20 (as variously amended in the 10/14/03 paper) are directed
18 toward a single invention, and respectfully request reconsideration of this point.

19 Secondly, the Applicants respectfully contend that it is not a requirement, for
20 multiple independent claims to be in an application, that there be a "generic or linking
21 claim". So long as the conditions of 37 C.F.R. 1.141 and MPEP §§ 802 and 806 are met
22 (i.e., the claimed inventions are not separate and distinct), multiple dependent claims
23 can exist within a single application, without the need for a "generic" or "linking" claim.
24 As set forth in the 10/14/03 paper, the Applicants contend that claims 1-20 are not
25 directed to separate and distinct inventions.

1 The Examiner is respectfully requested to review again Applicants' arguments
2 presented in the 10/14/03 paper in favor of including claims 1-8 and 16-20 with claims
3 9-15, and reconsideration on this point is respectfully requested.

4 As will be discussed further below, the Applicants contend that claims 2, 5 and 8
5 should be allowed if rewritten in independent form. However, in light of the unresolved
6 status of these claims, the Applicants do not wish to incur the fees at this time that are
7 required to enter these claims as independent claims. If the Examiner agrees that
8 claims 1-8 should be included in the present application, and that claims 2, 5 and 8 are
9 allowable, then the Applicants' will submit a supplemental amendment to put claims 2, 5
10 and 8 in independent form.

11
12 Rejection of claims 9-15 under U.S.C. § 103

13 Claims 9-15 have been rejected under 35 U.S.C. § 103 as being obvious over
14 U.S. Patent No. 5,967,824 (Neal et al. – hereinafter “Neal”) in view of U.S. Patent No.
15 5,619,660 (Scheer et al. – hereinafter “Scheer”).

16 As a starting point, MPEP 706.02(j) states:

17 [t]o establish a *prima facie* case of obviousness, three basic criteria
18 must be met. First, there must be some suggestion or motivation, either in
19 the cited references themselves or in the knowledge generally available to
20 one of ordinary skill in the art, to modify the reference or to combine the
21 reference teachings. Second, there must be a reasonable expectation of
22 success. Finally, the prior art reference (or references when combined)
23 must teach or suggest all the claim limitations. The teaching or suggestion
24 to make the claimed combination and the reasonable expectation of
25 success must both be found in the prior art and not based on applicant's
disclosure. (Emphasis added.)

1 Claims 9 and 10 have been cancelled, and therefore the rejection of those claims
2 is now moot.

3 Claim 11 includes the following limitations:

4
5 a controller having a **diagnostic program**, the diagnostic program
6 being configured to perform diagnostics on the associated module and to
7 generate the authorization command as a service signal when the
8 diagnostic program determines that the associated module should be
9 physically removed from the system for service, and wherein the service
10 signal is used to cause the actuator to move the securing member from the
11 first position to the second position.
12

13 Neither Neal nor Scheer teach or suggest a diagnostics program configured to
14 generate a service signal as per Applicants' claim 11, nor the use of a service signal to
15 cause the actuator to move the securing member (as also per Applicants' claim 11).
16 Since neither Neal nor Scheer teach or suggest all of the limitations of Applicants' claim
17 11, the §103 rejection of this claim cannot be maintained, and the rejection must be
18 withdrawn.

19 For at least this reason the Applicants contend that instant claim 11 is
20 allowable. As claim 12 depends from claim 11, it too is allowable for at least this
21 reason, in addition to its own respective merits.

22 Specifically, claim 12 includes the following limitation: "wherein the controller is
23 further configured to cause the associated module to be removed from service with
24 respect to the plane prior to causing the actuator to move the securing member from the
25 first position to the second position." Neither Neal nor Scheer teach or suggest this
limitation. In fact, Scheer is primarily directed to an apparatus for moving electrical
contacts in an IC card housing away from the path of an IC card being inserted into the

1 card housing so that electrical shorting across contacts on the IC card does not occur as
2 the IC card is being inserted into (or removed from) the housing. (See Scheer, Col. 3
3 lines 14-18.) If the contacts of the IC card housing of Scheer were removed from service
4 by the controller, then there would be no need to physically isolate the electrical contacts
5 in the housing from the contacts on the IC card. Accordingly, the position mechanism
6 (625, Fig. 6) of Scheer is designed, at least in part, to avoid making contact with in-
7 service connectors (connectors 621/622) as the IC card is inserted into, and removed
8 from, the housing 600, and thus Scheer teaches away from removing the contacts from
9 service prior to moving the positioning mechanism (623) away from the IC card, in
10 contrast to Applicants claim 12.

11 For at least this additional reason the Applicants contend that claim 12 is
12 allowable over Neal and Scheer.

13 Claim 13 includes the following limitations: "a securing member sensor
14 configured to detect when the securing member is in the first or the second position, and
15 to generate a position signal in response thereto."

16 The Examiner has stated that the "insertion detector 750" of Scheer (Fig. 7, item
17 750) is the same as the Applicants' claimed "securing member sensor." The Applicants
18 respectfully disagree. As indicated above, the "securing member sensor" of Applicants'
19 claim 11 is configured to detect when the securing member is in the first or the second
20 position. The insertion detector of Scheer, by contrast, is configured to "detect the
21 presence of an IC card during insertion and to detect the full insertion of an appropriately
22 keyed IC card." (See Scheer, Col. 10 lines 55-58; emphasis added.) As is clear, the
23 insertion detector 750 of Scheer does not detect the position of the securing member (as
24 is required by Applicants' claim 11), but rather detects the presence of an IC card. Since
25 neither Neal nor Scheer teach or suggest the limitation of a securing member sensor
configured to detect when the securing member is in the first or the second position, as
required by Applicants' claim 11, the §103 rejection of this claim cannot be maintained.

1 For at least this reason, the Applicants contend that instant claim 13 is
2 allowable. As claims 14 and 15 depend from claim 13, they too are allowable for at least
3 this reason, in addition to its own respective merits.

4
5 Claims 1-8 and 16-20

6 As discussed above, the Applicants contend that the inventions set forth in claims
7 1-8 and 16-20 are not "separate and distinct" from the invention set forth in claims 9-15,
8 and that the withdrawal of claims 1-8 and 16-20 by the Examiner was improper.
9 Accordingly, the Applicants believe that the search performed by the Office for claims 9-
10 15 is equally applicable to claims 1-8 and 16-20. The Applicants have therefore
11 reviewed claims 1-8 and 16-20 in light of the cited references (Neal and Scheer), and
12 believe that at least some of claims 1-8 and 16-20 are allowable. Specifically:

13 Claim 2 includes the following limitations: "wherein the first connector defines a
14 first receiving opening configured to receive the securing member, the second connector
15 defines a second receiving opening configured to receive the securing member, and
16 wherein when the connectors are coupled when the receiving openings are at least
17 partially in alignment." These limitations are simply not shown by either Neal or Scheer,
18 either separately or in combination. Referring to Fig. 3 of Neal, first connector 206 is
19 configured to be received within second connector 203. Neither of these connectors is
20 shown as having a receiving opening defined therein. With respect to Figs. 3A and 6 of
21 Scheer, first connector (in the receiving housing, Fig. 6) comprises either the bus bar
22 640, or the contacts 621 and 622, and second connector (in the IC card, Fig. 3A)
23 comprises either bus bar 340, or contacts 322/332. None of the connectors depicted by
24 Scheer have openings defined therein. While contacts 322/332 are positioned with
25 recesses (320/330), this is not the same as defining opening within the connectors. And
certainly neither Neal nor Scheer teach or suggest openings in connectors that are

1 aligned when the connectors are aligned, as required by Applicants' claim 2, as required
2 by Applicants' claim 2.

3 With respect to claim 5, that claim includes the following limitations: "a securing
4 member sensor configured to detect when the securing member is in the first or the
5 second position, and to generate a position signal in response thereto." As described
6 above with respect to claim 13, neither Neal nor Scheer teach or suggest this limitation.
7 Specifically, the "insertion detector" of Scheer (item 750, Fig. 7) is described as detecting
8 the presence of the IC card, not the presence or position of the positioning mechanism
9 625 (Fig. 60). (See Scheer at Col. 10, lines 54-58.)

10 Claim 6 (which depends from claim 5) includes the following limitation: "wherein
11 the position signal [generated by the securing member sensor] is used to notify a user of
12 the status of the securing member." Neither Neal nor Scheer (and specifically, Scheer)
13 teach or suggest any mechanism for informing a user of the position of the positioning
14 mechanism 625 (Fig. 60).

15 With respect to claim 8, that claim includes the following limitations: "wherein the
16 authorization command [of claim 1] is generated automatically by a control unit, and
17 wherein the control unit is configured to remove the first and second connectors from
18 service prior to authorizing moving the securing member to the second position."
19 Neither Neal nor Scheer teach or suggest these limitations. Specifically, with respect to
20 Scheer, as indicated at Col. 10, lines 6-23, the controller 626 (Fig. 6) is configured to
21 respond to commands from the user – no automatically generated commands are taught
22 or suggested. Furthermore, Scheer does not teach or suggest that the controller 626
23 can remove the connectors from service prior to moving the positioning mechanism 625,
24 as is required by Applicants' claim 8.

25 With respect to claim 16, that claim includes the following limitations:

(Continued on next page.)

1 A method for securing a first connector to a second connector,
2 comprising:

3 providing an arresting surface configured to restrict movement of the
4 first connector when the arresting surface is contacted by a force applied to
5 the first connector;

6 . . .

7 in response to the authorization command, moving the securing
8 member to the second position in proximity to the arresting surface to
9 thereby restrict relative movement between the first and second connectors.

10 (Emphasis added.)
11

12 Neither Neal nor Scheer teach these limitations. Specifically, with regard to
13 Scheer, the arresting surface is the back wall 401 of the housing 400 depicted in Fig. 5A.
14 The positioning mechanism 623 (Fig. 6) clearly does not move in proximity to the
15 arresting surface to restrict relative movement between the first and second connectors.
16 In fact, as is evident from Fig. 6 of Scheer, the positioning mechanism 623 must move
17 away from the IC card housing surfaces in order to restrict movement between the
18 connectors on the IC card (Fig. 3A) and the connectors on the housing (Fig. 6).

19 Since claims 17-20 depend from claim 16, they are also allowable over the
20 references for at least the same reasons as claim 16 is allowable, as elaborated in part
21 hereafter.

22 Specifically, claim 17 includes the following limitations: "and further comprising
23 detecting the position of the securing member, and reporting the position of the securing
24 member to a controller." As described above with respect to claims 5 and 13, neither
25 Neal nor Scheer teach or suggest these limitations. Specifically, the "insertion detector"
of Scheer (item 750, Fig. 7) is described as detecting the presence of the IC card, *not*
the presence or position of the positioning mechanism 625 (Fig. 60). (See Scheer at

Col. 10, lines 54-58.) Accordingly, claim 17 includes limitations not taught or suggested by either Neal or Scheer.

Claim 19 (which depends directly from claim 18, and indirectly from claim 16) includes the following limitations: "further comprising removing the connectors from service prior to moving the securing member back to the first position [i.e., the position which allows relative movement between the first and second connectors]." Neither Neal nor Scheer (and specifically Scheer) teach or suggest removing the connectors from service prior to moving the positioning mechanism (Scheer, item 623, Fig. 6) to the position which allows the IC card to be removed from the housing 600. Accordingly, claim 19 includes limitations not taught or suggested by either Neal or Scheer.

Claim 20 (which depends directly from claim 18, and indirectly from claim 16) includes the following limitations: "further comprising notifying a user when the securing member has been moved back to the first position [i.e., the position which allows relative movement between the first and second connectors]." Neither Neal nor Scheer teach or suggest this limitation. Accordingly, claim 20 includes limitations not taught or suggested by either Neal or Scheer.

Since neither Neal nor Scheer teach or suggest all of the limitations of Applicants' claims 2, 5, 6, 8 and 16-20, and since the inventions set forth in these claims are not separate and distinct from the invention set forth in claims 9-15 (as argued above), these claims should be allowed. As indicated above, upon receipt of a notice of allowability for claims 2, 5, 6, 8, claims 2, 5 and 8 will be amended to place them in independent form, to include the limitations of the base claim (claim 1) from which they originally depended.

Fee for additional claim


The fee for one (1) additional independent claim is to be charged to the Applicants' deposit account, as indicated on the attached transmittal cover letter.

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The Applicants note that the cancellation of claims 9 and 10 should not be considered as a concession by the Applicants that the canceled claims are anticipated by, or are obvious in light of, the cited references. Rather, the indicated claims are being canceled to facilitate allowance of other claims, as indicated herein.

The Examiner is respectfully requested to contact the below-signed representative if the Examiner believes this will facilitate prosecution toward allowance of the claims.

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